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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,070	03/20/2001	Curtis E. Stevens	01-1006	1670

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EXAMINER

ZHEN, LI B

ART UNIT	PAPER NUMBER
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2126

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/813,070	<b>Applicant(s)</b> STEVENS, CURTIS E.	
	<b>Examiner</b> Li B. Zhen	<b>Art Unit</b> 2126	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1 – 18 are pending in the application.

***Response to Arguments***

2. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 – 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
5. Applicant recites the limitation “one or more generic abstraction layers” in claim 1 (line 4), claim 2 (lines 2 – 3), claim 7 (line 1) and claim 8 (lines 1 – 2). There does not appear to be a written description of the claimed limitation in the application as filed. At best, the specification refers to generic device drivers (p. 3, lines 3 – 7; p. 7, lines 18 – 23 and 27 – 34; p. 8, lines 1 – 2 and 28 – 31), but not generic abstraction layers.

Therefore, the applicant fails to disclose "one or more generic abstraction layers" in the specification as filed.

***Specification***

6. Claims 12 and 13 are objected to under 37 CFR 1.75(c), as being of improper form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These two claims are identical to each other.

***Claim Rejections - 35 USC § 101***

7. Claims 1 – 9 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter.

8. Claims 1 – 9 are directed to method steps which can be practiced mentally in conjunction with pen and paper, therefore they are directed to non-statutory subject matter. Specifically, as claimed, it is uncertain what performs each of the claimed method steps. Moreover, each of the claimed steps, inter alia, providing can be practiced mentally in conjunctions with pen and paper. The claimed steps do not define a machine or computer implemented process [see MPEP 2106]. Therefore, the claimed invention is directed to non-statutory subject matter. (The examiner suggests applicant to change "method" to "computer implemented method" in the preamble to overcome the outstanding 35 U.S.C. 101 rejection).

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1, 2, 5 – 11 and 14 – 18 are rejected under 35 U.S.C. 102(e) as being anticipated by – U.S. Patent NO. 6,725,294 to Moore et al. [hereinafter Moore].**

11. As to claim 1, Moore teaches a method for controlling a removable media device [peripheral devices, such as the hard drives 214 and 216, the floppy drives 218 and 220 and the common handler device 224, Fig. 5; col. 5, lines 45 – 50] coupled to a computer system [computer 200, Fig. 5; col. 5, lines 40 – 45] by way of a bus interface [bus system 222, Fig. 5; col. 5, lines 27 – 29], the computer system having system firmware [BIOS program 226, Fig. 5; col. 5, lines 43 – 45], the method comprising the step of:

providing one or more generic abstraction layers [device handler, or device driver, 228, 230, 232, 234 and 236, Fig. 5; col. 5, lines 56 – 60] in the system firmware [device handlers 228-236 are supplied by "BIOS extensions" conventionally stored in the ROM 206; col. 5, lines 60 – 65] that employ interrupt 13 functions [insertion of a new INT 13h vector 240 for the new device handler 228-236 and the retention of the previous INT 13h vector 240 by the new device handler 228-236 is commonly referred

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to as "hooking the INT 13h."; col. 6, lines 1 – 18] to allow a program to communicate with the removable media device [access to a desired peripheral device 214-220 or 224 is requested, e.g. by a program; col. 6, lines 40 – 45].

12. As to claim 2, Moore teaches the removable media employed with the removable media device comprises a device driver that calls the one or more generic abstraction layer in the system firmware [device handlers 228-236 are supplied by "BIOS extensions" conventionally stored ...on a printed circuit board...for the peripheral devices 214-220 and 224; col. 5, lines 55 – 67].

13. As to claim 5, Moore teaches the removable media device is selected from the group including a CD-ROM device [a compact disk (CD-ROM); col. 5, lines 34 – 36], a DVD device, or a magneto-optical device [one or more hard drives 214 and 216 and one or more floppy drives 218 and 220; col. 5, lines 18 – 29].

14. As to claim 6, Moore teaches the program comprises an operating system or application [col. 6, lines 40 – 45].

15. As to claim 7, Moore teaches the one or more generic abstraction layers comprises interrupt 13 functions 40b and above that allow the program to access the removable media device in its native mode [flow of control over an access request as it

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is passed through and between the INT 13h and 40h chains 298 and 300; col. 7, lines 43 – 54].

16. As to claim 8, Moore teaches the one or more abstraction layers comprises interrupt 13 functions 1-3Fh [col. 7, lines 7 – 19] that allow the program to access the removable media device as a floppy drive [common handler device 224 may emulate either a bootable floppy drive or a bootable hard drive or may reference an executable application; col. 5, lines 36 – 43].

17. As to claim 9, Moore teaches the bus interface is selected from the group including a Universal Serial Bus, an IEEE-1394 bus, a Bluetooth bus, an ATA bus, an ATAPI bus, Peripheral Component Interconnect bus, Infiniband bus, or a SCSI bus [col. 5, lines 18 – 43].

18. As to claims 10, 11 and 14 – 18, these are apparatus claims that correspond to method claims 1, 2 and 5 – 9; note the rejections to claims 1, 2 and 5 – 9 above which also meet these apparatus claims.

### ***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. **Claims 3 – 4 and 12 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore in view of U.S. Patent NO. 6,170,055 to Meyer et al. [hereinafter Meyer, cited in previous office action].**

21. As to claims 3 and 4, Moore does not specifically teaches the removable media is used to perform recovery of contents of a device coupled to the computer.

However, Meyer teaches a removable media is used to perform recovery of contents of a device coupled to a computer [col. 10, lines 45 – 51].

22. It would have been obvious to a person of ordinarily skilled in the art at the time of the invention to apply the teaching of using a removable media to perform recovery of contents of a device coupled to a computer as taught by Meyer to the invention of Moore because this allows the user runs the recovery software from the hard disk or the floppy recovery disk to boot the system and to attempt to correct the cause of the failure in the event of a failure or error [col. 1, lines 55 – 57 of Meyer].

23. As to claims 12 and 13, these are rejected for the same reasons as claims 3 and 4 above.

### ***Conclusion***

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Form PTO-892.




25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li B. Zhen whose telephone number is (571) 272-3768. The examiner can normally be reached on Mon - Fri, 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Li B. Zhen  
Examiner  
Art Unit 2126

lbz  
September 6, 2004

  
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